

REMARKS

A Final Office Action was mailed on March 31, 2004. A response was filed timely on July 23, 2004 including a declaration by the inventor, Mr. Pau (Pau declaration). An Advisory Action was mailed on September 16, 2004. An appeal was filed timely on September 30, 2004.

Herewith, a Request for Continued Examination is filed and the present Response to Office Action is filed to advance the application and place the claims in condition for allowance.

Claims 1-4 and 6-18 are pending, of which claims 1, 14, and 17 are independent claims. By the foregoing claim 14 is amended and claims 19 and 20 are newly presented. Other amendments are made for grammatical reasons.

Claims 1-4, 6-9, 12, and 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,450,883 to O'Hallaron ('883 patent) in view of U.S. Patent No. 5,788,573 to Baerlocher et al. Claims 10, 11, 13, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over O'Hallaron in view of Baerlocher and in further view of U.S. Patent No. 6,315,660 to DeMar et al.

The present invention is a gaming machine having an underlying game, i.e. base game, and a triggering event for a secondary game. As claimed by all independent claims, the triggering event precludes the player from winning a prize in the underlying game but permits the player an opportunity to win a prize in the secondary game where the theoretical return to player is greater than in the underlying game. In this respect the return to player percentage (RPP) is increased relative to only the underlying game being played.

Of course, one may further consider that the inventive teaching of the present application is that the RPP of only the underlying game may be reduced while the RPP of the underlying game and the secondary game may still meet the statutory/regulatory requirements. In fact, as taught by the figures and examples of the specification the RPP of the secondary game is greater than 100%. For example, a ratio of winning one 1000 credit prize or multiple prizes totaling 1000

credits over 8 plays is envisioned, when each time 100 credits are wagered. This would produce an RPP of 125% for the secondary game and thus permit the underlying game to have a reduction in the RPP. Such an arrangement advantageously would create further excitement and raise it to a new level for players who may experience a drought only to be rewarded by a deluge of the larger prize at the end.

Neither O'Hallaron or O'Hallaron and Baerlocher reach or suggest the claimed limitations. Consequently, neither O'Hallaron or O'Hallaron and Baerlocher appreciate the fundamental teaching of the present invention that the theoretical return for the underlying game, which is not concluded upon a triggering event until the secondary game is concluded, is increased by the secondary game.

O'Hallaron suggests an underlying game wherein upon winning a prize in the underlying game; a bonus game becomes available to the player for the opportunity to further wager the winnings of the underlying game. The player may decline to play the bonus game and collect his winnings. If the player chooses to wager the winnings in the bonus game, the return to player percentage (RPP) of the wager is the same as that what is being wagered, i.e. 100%. This is taught by O'Hallaron by way of examples in the paragraph bridging columns 3 and 4, where 1 card in 2 wager results in a doubling payoff, a 1 card in 4 wager results in a quadrupling, etc.

The present argument was at least the subject of the Pau Declaration. Applicant, through applicant's attorney, respectfully submits that the Examiner has misunderstood the declaration and respectfully requests that the Examiner reconsider the Pau Declaration. While the odds of winning taught by O'Hallaron is at best is 50%, the RPP is neutral since O'Hallaron teaches that the odds are the inverse of the multiplier of the wagering amount. Thus, as discussed, O'Hallaron is neutral to the RPP, which is typically 0.85.

As detailed in the Pau declaration no person skilled in the art would combine the O'Hallaron and Baerlocher given that the bonus structure of the game and the structure of the games are substantially different.

Furthermore, as Baerlocher teaches in the abstract the odds of the entering a bonus game is 1:50 1:40 on landing on a bonus position, and a very slim 1:8,000,000 on winning the jackpot. See also, col. 8, lines 54, and col. 9, lines 12 et al. Therein, Baerlocher does not teach, nor is there any reason, to suggest that the winnings are intended to adjust the RPP of the underlying game. The jackpot is designed as a progressive value that is related to the coins in the machine. There is no teaching that the value ought to be of such a size as to provide a return sufficient to affect the RPP. No such suggestion or teaching is made in O'Hallaron since O'Hallaron teaches a neutral effect on the RPP.

In contrast, the present invention teaches an increasing player return, i.e. total theoretical return. Thus, once a secondary game has been initiated, the player is likely to have a significant win, which is why the bonus spinning wheels do not appear after every win, but only after a predefined triggering event. The Examiner is respectfully requested to withdraw the rejection under O'Hallaron and/or O'Hallaron and Baerlocher.

In view of the remarks set forth above, this application is in condition for allowance which action is respectfully requested. All dependent claims are allowable for at least the same reasons as those of the independent claims from which they depend.

If for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



Hassan A. Shakir
Reg. No. 53,922
(212) 940.6489

CUSTOMER NUMBER 026304

Fax: (212) 894-5684 (direct fax)

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